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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK BRESNAN and JE H. OH

Appeal 2011-005760
Application 09/628,496¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ This is a reissue application for US Patent 5,873,073, filed Dec. 24, 1996.

STATEMENT OF THE CASE

Mark Bresnan, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-21, 23-40, and 42-52. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM but denominate the affirmance as a new ground of rejection pursuant to 37 C.F.R. 41.50(b).²

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of defining and producing a finished mail piece, comprising the steps of:
 - (a) selecting at a first node, a plurality of characteristics which together define a mailing;
 - (b) creating a document and storing said document in electronic form, then directing that said stored document be included in a print job comprising said mailing;
 - (c) creating an address list comprising one or more destination addresses and storing said address list in electronic form and then selecting said stored address list for inclusion in said print job;
 - (d) transmitting electronically said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;

² Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Aug. 13, 2010) and the Examiner's Answer ("Answer," mailed Nov. 12, 2010).

(e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:

(i) a first printer; and

(ii) a second printer;

(f) printing on said first printer said destination address to an envelope wherein each of said destination addresses is printed to a corresponding envelope;

(g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node;

(h) inserting said printed document into said printed envelope to form an unfinished mail piece;

(i) sealing said unfinished mail piece;

g) franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece; and

(k) placing said finished mail piece into a mail stream for delivery to said destination address printed thereon.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Rosenbaum	US 5,031,223	Jul. 9, 1991
Seki	US 5,121,195	Jun. 9, 1992
Lombardo	US 5,346,123	Sep. 13, 1994
Humes	US 5,377,120	Dec. 27, 1994
Cordery	EP 0 719 597 A2	Jul. 3, 1996

The following rejections are before us for review:

1. Claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51, and 52 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery and Humes.
2. Claims 2, 30, 31, and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Seki, and Lombardo.
3. Claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Rosenbaum.

ISSUES

The issues are whether the cited prior art disclose the first and terminal nodes as claimed and, as claimed, such that “said terminal node is not co-located with, nor under the control of, said first node” (claim 1).

FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Answer (Ans. 16-22). Additional findings of fact may appear in the Analysis below.

ANALYSIS

The rejection of claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51, and 52 under 35 U.S.C. §103(a) as being unpatentable over Cordery and Humes.

The Appellants argued claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51, and 52 as a group (Br. 6). We select claim 1 as the representative claim for this group, and the remaining claims 5-21, 23-29, 32, 34, 37-40,

42, 43, 47, 51, and 52 stand or fall with claim 1. 37 C.F.R.
§ 41.37(c)(1)(vii) (2007).

The issues implicate the obviousness factual inquiry over the scope and content of the prior art.

The claimed invention is drawn to methods and systems for producing a mail piece via a first node and a terminal node and where the terminal node is “not co-located with, nor under the control of, said first node” (claim 1; see also the other independent claims 15, 20, and 38 which use the same language).

The Examiner has taken the position that both Cordery and Humes disclose a first node and a terminal node.

According to the claims, the function of the first node is to select a “plurality of characteristics which define a mailing.” According to the Specification certain characteristics can define a “mailing.” “These characteristics include selection of a document to be printed at a terminal node and a list of addresses to which the printed document will be sent.” Col. 2, ll. 22-25 of US Patent 5,873,073 [‘073].

Additionally, the characteristics include a choice of: paper type; ink color; paper color; paper size; duplex or simplex printing on the chosen paper; a choice of whether or not a reply envelope is to be printed; and, a choice of how the chosen paper is to be folded.
‘073, col. 2, ll. 25-30.

The Examiner equates element 52 in Cordery with the first node as claimed. See Answer 16. The Appellants appear to dispute that, arguing that “there is no information that is selected at the host computer 52.” Br. 8.

We have reviewed Cordery and find we are in agreement with the

Examiner that Cordery's host computer 52 functions to select a "plurality of characteristics which define a mailing," as claimed. Starting at line 58 of col. 2 through col. 4, l. 35, Cordery describes the data which is gathered, accessed and/or extracted for generating job data. The data covers the types of information the claimed invention covers as defining a "mailing." See, e.g., "addresses" at col. 4, l. 10. This is all received by host computer 52. While "selecting", per se, is not expressly disclosed, Cordery does explain that the computer need not operate only under default values but can be programmed to "generate varying data for the mail piece header" (col. 4, ll. 34-35). Selection is thereby implicitly disclosed. In evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

The Examiner has also equated elements 23-26 of Humes with the first node as claimed. See Answer 30. The Appellants disagree with that characterization. Br. 10 ("There is no device discloses in Humes that corresponds to a first node at which a plurality of characteristics which together define a mailing is selected.")

We have reviewed Humes and find we are in agreement with the Appellants. Elements 23-26 represent databases with data received from merchants or other mailing service customers. Col. 3, ll. 28-36. The databases contain addresses (the other types of information they may contain is unclear). Col. 3, ll. 34-36. Elements 23-26 do not function so that characteristics defining a mailing can be selected. They merely store data.

As Humes illustrates, elements 23-26 can simply be floppy disks. Col. 4, l. 14.

Turning now to the terminal node.

According to the claims, the function of the terminal node is to receive the address list and characteristics (as part of a print job) and direct the document, the address list, and characteristics to a mail production means.

The Examiner indicates that element 50 in Cordery discloses a terminal node as claimed. See Answer 16. The Appellants do not appear to dispute this. Accordingly, we take as accepted that Cordery discloses a terminal node for receiving the address list and characteristics (as part of a print job) and directing the document, the address list, and characteristics to a mail production means. Even if we assume *arguendo* that the Appellants' arguments implicitly dispute this characterization of what Cordery discloses, we would nevertheless disagree. Cordery discloses printer controller 58 (which is a part of element 50) which functions in the manner claimed for the terminal node. See col. 4, ll. 54-57:

Printer controller 58 receives job data 10 from host 55 computer 52 and parses the data; sending the attribute data from either job header 12 or mail piece header 18 to mail finishing unit controller 100, and sending document data 20 to document printer engine 60

The Examiner also relies on elements 29, 51, and 57 of Humes as disclosing the terminal node as claimed. These are disclosed as representing a "first computer," "a merged database" or "printer," and a "sequence controller," respectively. Col. 4. However, given that we find that Cordery discloses the claimed terminal node and that Humes does not disclose the

first node as claimed, we need not resolve whether the claimed terminal node also reads on Humes elements 29, 51, and 57.

Given our view that Cordery discloses the first node and terminal nodes as claimed, the question becomes whether the “terminal node is not co-located with, nor under the control of, said first node” (claim 1).

To answer this question, we must first construe what is meant by “not co-located” and “nor under the control of.” The claims themselves provide no specifics. A plain reading of the claims provides one of ordinary skill in the art no insight into the limits being placed on the terminal node such that it would not be “co-located” with or under the “control” of the first node. Nor does the Specification provide any definition for these terms. Accordingly, we will give them their ordinary and customary meaning. In that regard, “co” means “jointly.” *See Webster’s New World Dictionary* 266. (3rd Ed. 1988.)(Entry for “co-.”) And “control” means “to exercise authority over.” *See Webster’s New World Dictionary* 303. (3rd Ed. 1988.)(Entry for “control.”) Accordingly, the broadest reasonable construction of the claims in light of the Specification as they would be interpreted by one of ordinary skill in the art is such that the terminal node is required to be not jointly located and not under the authority of the first node.

Given this construction, we turn to Cordery. Cordery shows host computer 52 (first node) and printer controller 58 (terminal node) in Fig. 3 as being close to each other. But they are not jointly located. The associated disclosure at col. 4, ll. 36-45 explains that the printer controller is preferably included in a laser printer. Normally a computer and a printer are separate apparatuses located apart from each other. Accordingly, one of ordinary

skill in the art reading Cordery would understand the printer controller 58 (terminal node) to not be “co-located” to computer 52 (first node).

Regarding “control,” Cordery discloses that “it is a particular advantage of the subject invention that host computer 52 connects to document printer 56 [which includes printer controller 58] in a manner which is substantially identical to the manner in which microcomputers connect to conventional laser printers” (col. 4, ll. 45-50). As is conventional, printers function in only two alternative ways - either under the control of a computer to which they are linked or independent thereof. Arguably, Cordery’s host computer 52 advantageously controls document printer 56 and thus printer controller 58. However, Cordery does not exclude or teach away from having the printer function in the conventional alternative; that is, perform its task independently and not under the control of the computer. Cf. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.”)

Accordingly, we find that that Cordery shows the first node (host computer 52) and the terminal node (printer controller 58) such that the “terminal node is not co-located with ... said first node” (claim 1) and that a “terminal node ..., [not] under the control of, said first node” would have been obvious to one of ordinary skill in the art over Cordery.

For the foregoing reasons, we are unpersuaded by the Appellants' arguments as to error in the rejection of claim 1 as being unpatentable of Cordery alone. Because claims 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51, and 52 stand or fall with claim 1, we reach the same conclusion as to these claims.

The rejection of claims 2, 30, 31, and 33 under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Seki, and Lombardo.

We also shall sustain the standing 35 U.S.C. § 103 rejection of dependent claims 2, 30, 31, and 33 as being unpatentable over Cordery, Humes, Seki, and Lombardo since the Appellants have not challenged such with any reasonable specificity, thereby allowing claim 2, 30, 31, and 33 to stand or fall with parent claims 1 and 20 (see *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

The rejection of claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Rosenbaum.

We also shall sustain the standing 35 U.S.C. § 103 rejection of dependent claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 as being unpatentable over Cordery, Humes, Seki, and Lombardo since the Appellants have not challenged such with any reasonable specificity, thereby allowing claim 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 to stand or fall with parent claims 1, 15, 20, and 38.

DECISION

The decision of the Examiner to reject claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51, and 52 under 35 U.S.C. §103(a) as being unpatentable over Cordery and Humes; claims 2, 30, 31, and 33 under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Seki, and Lombardo; and, claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 under 35 U.S.C. §103(a) as being unpatentable over Cordery, Humes, Rosenbaum are affirmed. However, we designate our affirmance as a new ground of rejection since our reasoning above differs from that of the Examiner.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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AFFIRMED; 37 C.F.R. § 41.50(b)

MP